

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Temple

Serial No.: 10/827,493

Group No.: 3739

Filed: April 19, 2004

Examiner: M. Kasztejna

For: HEATER FOR SURGICAL VIEWING INSTRUMENTS

**APPELLANT'S REPLY BRIEF UNDER 37 CFR §41.41**

Mail Stop APPEAL BRIEF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed June 1, 2007, Appellant hereby submits its Reply Brief.

**New Grounds of Objection/Rejection To Be Reviewed On Appeal**

A. The rejection of claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,910,106 to Morgan et al.

B. The rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Publication No. 2002/0022762 to Beane et al.

**Argument**

A. The Rejection of Claims 1, 2 and 4 under 35 U.S.C. §102(b)

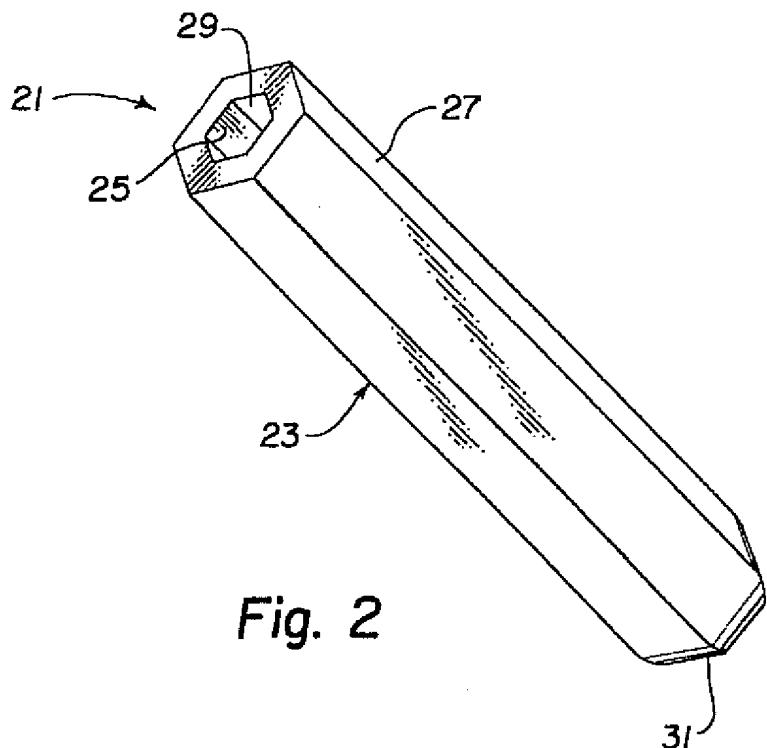
Appellant's claim 1 includes the limitations of a flexible pad for wrapping around an instrument such as an endoscope to warm the instrument. The pad includes one or more elongate partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.

Claims 1 stands rejected under 35 U.S.C. §102(b) over Morgan et al. ('106). The Examiner's interpretation of the reference is unreasonable. The Examiner relies on Figure 2 of the

'106 patent, which is reproduced below. Morgan et al. describe the figure as follows at col. 4, lines 33-51:

"FIG. 2 is a side perspective view of an instrument heater 21 according to the teachings of the present invention. The instrument heater 21 is cylindrically-shaped. The instrument heater 21 includes a sheath 23. The sheath 23 has an inner wall 25 and an outer wall 27 running across the entire length of the sheath 23. The inner wall 25 and the outer wall 27 form an essentially circular bore (not shown in FIG. 1) through the center of the sheath 23. At one end of the sheath 23 is an opening 29 which serves as the beginning of the bore. At an opposite end of the sheath 23 is a tip 31. The tip 31 is closed-ended and essentially dome-shaped.

"The inner wall 25 and the outer wall 27 are constructed of a flexible nonporous material allowing for the insulation of heat. In the disclosed embodiment, the material is chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath 23. However, any flexible and nonporous material capable of being sterilized may be used."



It should be clear from this description that the article of Morgan has a fixed, sleeve like shape (i.e., a 'sheath'). Nevertheless, the Examiner interprets the above article as a "pad." It is also the Examiner's position that, as broadly as claimed, Morgan discloses one or more elongate partitions running along the pad to establish fold lines, and wherein each partition including a gap to facilitate fluid transfer of the mixture. According to the Examiner, "[a]s seen in Figure 2, elongate

partitions are clearly seen running lengthwise along the [sheath] and create a folded area. Furthermore, in the broadest interpretation of the claim, the gap is understood as being the space between the inner wall and the outer wall 27." (Latest OA, p. 7)

These interpretations are repugnant to those understood by any person of skill in the art. The broadest reasonable interpretation must be consistent with the interpretation *that those skilled in the art would reach*. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Moreover, claim interpretation must be consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1988).

If Appellant's specification were consulted, the reader would be informed that the inventor did not depart from the common, reasonable definition of a pad; namely an article having a length, a width *and a periphery*. (See claim 1.) The sheath of Morgan has no periphery because it is not a pad. Nor does Morgan disclose "elongate partitions [that] create a folded area." The "partitions" to which the Examiner refers are outer edges. Edges are not partitions. The device of Morgan has no "folded area." Moreover, according to Appellant's claim 1, the partitions establish *fold lines*, not a "folded area," whatever that might be.

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Systems*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." *Connell v. Sears, Roebuck Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Morgan simply does not teach or suggest "a flexible pad ... for wrapping around the instrument." Nor does Morgan teach or suggest "one or more elongated partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture." Accordingly, *prima facie* anticipation has not been established.

B. Rejection of Claim 3

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent Application Publication No. 2002/0022762 to Beane.

The Examiner concedes that “Morgan et al. are silent as to a housing,” but argues that Beane et al. demonstrate housing [sic] … are known in the art.” *But this is not the standard.* Rather, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant’s claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. *In Re Dembeczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, since there is no teaching or suggestion from the prior art in support of the addition of a housing to Morgan et al., *prima facie* obviousness has not been established. Just because something is “known” does not mean it should be used in combination with something else.

Conclusion

For the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board’s concurrence at this time.

Respectfully submitted,

John G. Posa  
Registration No. 37,424  
Gifford, Krass, Sprinkle, Anderson  
& Citkowski, P.C.  
PO Box 7021  
Troy, MI 48007-7021  
(734) 913-9300

Dated: Aug. 1, 2007